

## PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: : John A. Zebala  
Application No. : 09/332,815  
Filed: : September 17, 1999  
For : *POROUS COATINGS BEARING LIGAND ARRAYS  
AND USE THEREOF*

Examiner : Cheryl Juska  
Art Unit: : 1771  
Docket No. : 7.004  
Customer # : 35188

Mail Stop RCE  
Commissioner for Patents  
P.O. Box 1450  
Washington DC 20231-1450

REPLY

Commissioner for Patents:

Applicant files this Reply in response to Examiner's rejection of claims raised in an interview on September 8, 2004. During the interview, Examiner and Applicant's attorney discussed the claims as presented in the Amendment, previously filed on August 10, 2004. Applicant gratefully appreciates the attention and time given by Examiner Juska before and during the interview.

In particular, Applicant responds to Examiner's office action, supplied during the interview, rejecting newly amended composition-of-matter claims 1-36 and 38-41 as obvious under 35 U.S.C. § 103 over Hendrickson and Zebala PN 6,159,681 ("the '681 patent").

Applicant responds pursuant to Applicant's agreement with Examiner, by filing a Declaration of Syntrix Biochip, Inc. ("Syntrix") to disqualify the '681 patent as prior art under 35 U.S.C. § 103(c).\*

\* Applicant notes that the filing date of the subject application, September 17, 1999, is prior to the effective date of the cited law, November 29, 1999. If Examiner deems necessary, Applicant will file a continuation

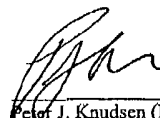
In its Declaration pursuant to 37 CFR § 1.104(a)(5), Syntrix avers that it is the common owner of the subject patent application and the '681 patent. Further, Syntrix avers that the inventor of the subject matter recited in rejected claims 1-36 and 38-41 (as currently pending) was under an obligation to assign those inventions to Syntrix, the common owner, at the time the inventions were made by virtue of inventor's employment agreement.

The assignment agreement was executed at the time the subject application was filed and was recorded, albeit with the wrong application number, in the Patent and Trademark Office at Reel /Frame No. 010235/0300-02. A copy of the Recordation Form Cover Sheet submitted on September 13, 1999, by Seed Intellectual Law Group, LLC, the original attorneys for the subject application, is attached. The form incorrectly listed the application number of the subject application. Syntrix explained this error in its April 30, 2004, letter, also attached.

Syntrix avers further that it was also assigned the entire rights in PN 6,159,681, which assignment was recorded in the Patent and Trademark Office at Reel/Frame No. 010216/0988.

Applicant hereby requests further examination and reconsideration of the claims of the subject application in view of the attached Declaration. Applicant believes that the Declaration disqualifies the '681 patent as prior art, overcomes the obviousness rejection of claims 1-36 and 38-41, and places these claims in condition for allowance.

Respectfully submitted,



Peter J. Knudsen (Reg. No. 40,682)  
Knudsen, Attorney at Law LLC

Attorney for Applicant

1771

Peter Knudsen, Attorney at Law LLC  
13710 Riviera Place NE  
Seattle, Washington 98125  
Telephone: 206-367-0259  
Fax: 206-367-5083  
[knudsen.llc@comcast.net](mailto:knudsen.llc@comcast.net)

**Peter Knudsen  
Attorney at Law LLC**

# Fax

<b>To:</b> Examiner Cheryl Juska	<b>From:</b> Peter J. Knudsen (Attorney for Applicant)
<b>Fax:</b> 571-273-1477	<b>Pages:</b> 13
<b>Phone:</b> 571-272-1477	<b>Date:</b> 9/9/2004
<b>Re:</b> <del>AN 09/326,479</del> (my ref: 7.004)	<b>CC:</b>

☒ **Urgent**    ☐ **For Review**    ☐ **Please Comment**    ☐ **Please Reply**    ☐ **Please Recycle**

● **Comments:**

Dear Examiner Juska:

I attach applicant's Reply and attached Declaration per results of yesterday's interview.

Respectfully submitted,

Peter Knudsen

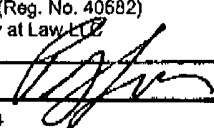
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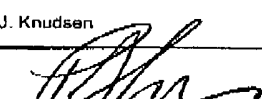
Approved for use through 07/31/2008. OMB 0651-0031

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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/332,815	
	Filing Date	September 17, 1999	
	First Named Inventor	John A. Zehala	
	Art Unit	1771	
	Examiner Name	Cheryl Juska	
Total Number of Pages in This Submission	12	Attorney Docket Number	7.004

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC)
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
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<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/> Other Enclosure(s) (please identify below):
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<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		
<b>SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT</b>		
Firm or Individual name	Peter J. Knudsen (Reg. No. 40682) Knudsen, Attorney at Law, LLC	
Signature		
Date	September 9, 2004	

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.		
Typed or printed name	Peter J. Knudsen	
Signature		Date
		September 9, 2004

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